

Applicant: Mueller , Peter S.
Application Serial No.: 10/750,118
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REMARKS

Claims 1, 3, 6, 7, 10, 11, 18, 19, 22, 23, 26-28 and 31-41 are pending in the application. Claims 35-38 were previously elected in view of the restriction requirement. Claim 35 has been amended. No new matter has been introduced.

Response to rejection under 35 U.S.C. §112

Claims 35-38 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that there is insufficient descriptive support for the phrase, "derivatives of sibutramine". Applicant traverses the rejection. However, in the interest of furthering prosecution, Applicant has amended claim 35 by deleting the phrase "derivatives of sibutramine". Therefore, in view of the amendment, the rejection is overcome.

Claims 35-38 have been rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for use of sibutramine, allegedly does not reasonably provide enablement for the use of derivatives of sibutramine. This rejection is respectfully traversed. However, in the interest of furthering prosecution, claim 35 has been amended to remove the phrase "derivatives of sibutramine". Applicant submits that in light of the amendment, the

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rejection under Section 112, first paragraph is obviated. Withdrawal of the rejection is respectfully requested.

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Summary

Applicant would like to thank the Examiner for the interview on August 21, 2007.

Applicants acknowledge that a simple deletion of an element after final would be allowable if the amendment removes the 112 rejection and does not broaden the claim beyond what has been previously claimed. Applicant acknowledges that the claims have not been rejected in view of prior art. The claims have only been rejected under 35 USC Section 112, first paragraph, directed only at the phrase “derivatives of sibutramine”. In the interest in furthering prosecution, this phrase has been deleted.

Furthermore, since claim 35 was directed to “sibutramine, sibutramine salts or derivatives of sibutramine”, the deletion of the “derivatives of sibutramine” does not overreach what has been previously presented in the claims. The search previously conducted included each element including “sibutramine or sibutramine salts”, as recited in amended claim 35. Accordingly, Applicant believes the claims are in condition for allowance and respectfully requests withdrawal of the rejections.

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Should the Examiner have any questions regarding this response or wish to discuss this matter in further detail, please contact the undersigned counsel.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anna-Lisa Gallo", is written over a horizontal line.

Anna-Lisa Gallo
Registration No.: 50,279
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700